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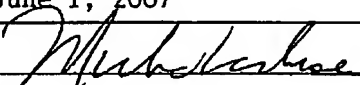
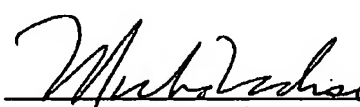
JUN 01 2007

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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|--|--|---|---------------------------|
| <b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>   |  | Docket Number (Optional)<br>37505.0281  |                           |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]<br>on <u>June 1, 2007</u><br>Signature <u></u><br>Typed or printed name <u>Michael F. Scalise</u> |  | Application Number<br>10/669,116  | Filed<br>09/23/2003       |
|  |  | First Named Inventor<br>Miller et al.   |                           |
|  |  | Art Unit<br>1745  | Examiner<br>A. Echelmeyer |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.   |  |   |                           |
| This request is being filed with a notice of appeal.   |  |   |                           |
| The review is requested for the reason(s) stated on the attached sheet(s).<br>Note: No more than five (5) pages may be provided.   |  |   |                           |
| I am the   |  | <br>Signature |                           |
| <input type="checkbox"/>   | applicant/inventor.  | Michael F. Scalise<br>Typed or printed name   |                           |
| <input type="checkbox"/>   | assignee of record of the entire interest.<br>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.<br>(Form PTO/SB/98) | 716-759-5810<br>Telephone number  |                           |
| <input checked="" type="checkbox"/>  | attorney or agent of record. <u>34,920</u><br>Registration number  | June 1, 2007<br>Date  |                           |
| <input type="checkbox"/>   | attorney or agent acting under 37 CFR 1.34.<br>Registration number if acting under 37 CFR 1.34                                 |   |                           |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.<br>Submit multiple forms if more than one signature is required, see below.   |  |   |                           |
| <input checked="" type="checkbox"/> Total of <u>2</u> forms are submitted.   |  |   |                           |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Michael F. Scalise

Name

Signature

June 1, 2007

Date of Signature

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:                    Miller et al.  
Serial No.                                :                    10/669,116  
Filed                                        :                    September 23, 2003  
For    :                    Implantable Current Collector  
   ID Matrix Identifier  
Examiner                                  :                    A. Echelmeyer  
Group Art Unit                            :                    1745

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Office Action dated June 1, 2007, the  
Applicants remark as follows:

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REMARKS

Claims 1, 2, 4, 7 to 17 and 19 to 27 are pending. No claims are allowed.

1. Claims 1, 2, 4, 7, 8, 12, 16, 17, 19 to 24, 26 and 27 are rejected under 35 USC 103(a) as being unpatentable over Lessar et al. (U.S. Patent No. 6,006,133) in view of Miyazaki et al. (U.S. Patent No. 6,315,801) and Merlin et al. (U.S. Patent No. 5,552,574).

In the Response to Arguments section of the office action, the examiner sets for her conclusion regarding the applicants' claimed invention beginning at the bottom of page 13 and continuing onto page 14. There she states the "[o]n page 13 of the remarks, Applicants state that there is no motivation within Miyazuki et al. to improve the marks by etching them: 'In other words, the Miyazuki et al. invention is complete and functional in and of itself and not one needing to be 'improved'.' Most modern inventions are made by improving an existing invention that previous (sp) may not have been believed to need improvement. Take, for example, a car. It is likely that Henry Ford believed that his Model T cars did not need improvement, but one need only sit in a car to see the many inventions that have improved cars, such as seatbelts or antilock brakes. The argument that an existing invention does not need further improvement goes against the whole purpose of invention."

The public policy behind awarding patents to inventors is to reward them for their patentable innovations and improvements. The implication being that most everything can

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be improved including cars and electrochemical cells. In that respect, the applicants did not mean to imply in their prior amendment that Miyazuki et al.'s cell could not be improved because, in fact, their presently claimed invention does just that. Instead, it is that one skilled in the art at the time of their invention having the benefit of Miyazuki et al. would not have been motivated to look to Merlin et al. because "the Miyazuki et al.'s invention is complete and functional in and of itself and not one needing to be 'improved'."

The examiner seems to have taken this completely out of context. It is not that Miyazuki et al.'s invention is incapable of being improved. Rather the issue is motivation to improve. One skilled in the art would not have believed that Miyazuki et al. should be improved because one would not have recognized that there was a problem with its solution. Since the patterned identification marks of Miyazuki et al. solve the problem inherent in "printed material [being] susceptible to damage (column 2 lines 58-67 of Miyazuki et al.)", then what motivation would one have to further improve Miyazuki et al.? It is the improvement. In other words, why does the improvement need to be further improved? It doesn't, unless one is cognizant of the applicants' claimed invention from a hindsight perspective.

Therefore, the examiner seems to have missed the point with her argument regarding Henry Ford and his Model T cars. Of course they have been improved many times over, and the vast majority of those improvements have been worthy of patent protection. This includes seatbelts and antilock breaks. In a similar vein, the prior art has been improved by the claimed invention, which is also worthy of patent protection. This, of

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course, is not to say that some day an inventor will not improve upon the applicants' invention. But from a reading of their specification, it is not readily apparent why one would work on such a further improvement. That is because the applicants' claimed "invention is complete and functional in and of itself and not one needing to be improved."


Reconsideration of this rejection is requested.

2. Claims 9 to 11, 13 to 15 and 25 are rejected under 35 USC 103(a) as being unpatentable over Lessar et al. in view of Miyazuki et al. and Merlin et al. as applied to claims 1 and 7 above, and further in view of Gan et al. (U.S. Patent No. 6,790,561). For the reasons stated above, independent claims 1 and 13 are allowable in light of the cited combination of prior art references. Claims 9 to 11, 14, 15 and 25 are patentable as hinging from allowable base claims.

Reconsideration of this rejection is requested.

It is believed that claims 1, 2, 4, 7 to 17 and 19 to 27 are in condition for allowance. Notice of Allowance is requested.

Respectfully Submitted,

  
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June 1, 2007